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## **I. REAL PARTY IN INTEREST**

The subject application is owned by National Instruments Corporation, a corporation organized and existing under and by virtue of the laws of the State of Delaware, and having its principal place of business at 11500 N. MoPac Expressway, Bldg. B, Austin, Texas 78759-3504.

## **II. RELATED APPEALS AND INTERFERENCES**

This appeal is not related to any other appeals.

## **III. STATUS OF CLAIMS**

Claims 1-44 were originally filed in the application. In an amendment filed August 14, 2002, claims 44-88 were added. In an amendment filed July 3, 2003, claims 1-88 were cancelled, and new claims 87-132 added, which were subsequently renumbered 89-134 in an amendment filed December 12, 2003. Claims 89-134 stand twice rejected and are the subject of this appeal. A copy of claims 89-134, as on appeal and incorporating entered amendments, is included in the Appendix hereto.

## **IV. STATUS OF AMENDMENTS**

No amendments to the claims have been filed subsequent to the rejection which was mailed March 31, 2004. The Appendix hereto reflects the current state of the claims.

## V. SUMMARY OF THE INVENTION

The present invention relates generally to the field of e-commerce, and particularly to the configuration of electronic systems, such as computer systems and measurement systems, over a network, such as the Internet.

Various systems have been developed for purchasing electronic products over the Internet. However, these systems have generally provided a very limited visualization capability to display the specific product being purchased by the prospective purchaser or user, e.g., displaying a bill of materials for the product being purchased which may provide specific components included with the product being purchased, but fail to provide a graphical visualization of the product being purchased, or displaying an image of a general product being ordered, but which may not represent the specific customized or configured product being purchased by the user. Purchasing of a configurable or complex electronic product, such as a computer system (Figure 6, Specification page 15, line 26 – page 17, line 6) or a measurement system, e.g., a test or automation system with numerous customizable attributes (see Figure 5, Specification page 14, line 15- page 15, line 21), complicates the purchasing decision for the user. A configurable product may include many user selectable or configurable components, which are often assembled and packaged together on a customized basis for a specific purchase order. However, with current e-commerce systems a user may experience difficulty in the selection or configuration of various options or components in the system, and may further experience difficulty in simply visualizing the various possible options or components in the system and their relative position or orientation with respect to the system as a whole.

The problems outlined above are in large part solved by a system and method that enables a user to visually or graphically configure and/or view a customizable electronic product, such as a computer system (Figure 6) or measurement system (Figure 5), e.g., for purchase in an e-commerce system. The e-commerce system preferably includes an e-commerce server (102 of Figure 1), e.g., maintained by an e-commerce vendor, which hosts an e-commerce site or a web site of the e-commerce vendor, and also preferably include a client system (106 of Figure 1) that includes web browser software for accessing the web site of the e-commerce vendor.

A user may launch the web browser on the client system to access the vendor's web site to purchase a customizable product (20/22 of Figure 2A, Specification page 9, line 9 – page 10, line 21), i.e., a computer system or measurement system, referred to as the system. The e-commerce server for the vendor's web site may present, in one embodiment, a forms or menu based GUI to display customizable component options of a computer system or measurement system on a client computer system (24/26 of Figure 2A, Specification page 10, lines 22 - page 11, line 3; Figure 3, Specification page 11, lines 4-12) from which a user may select one or more customizable component options of the computer system or measurement system. In another embodiment the GUI may be in the form of an image or graphics visually depicting the customizable computer system or measurement system (24/26 of Figure 2A, Specification page 10, line 22 - page 11, line 3; Figures 4 and 6; Specification page 11, line 13 – page 12, line 8). Images of the customizable components of the computer system or measurement system may be visually depicted on the client display in close proximity to their respective locations on the image of the customizable computer system or measurement system displayed. The user may select a customizable component for configuration by selecting the visually displayed image of the customizable component, wherein the customizable components may be positioned on the image of the customizable computer system or measurement system corresponding to their actual position in the system. After a customizable component has been selected, the customizable component options may then be selected, such as by using a pop-up menu or by the user selecting images of the options (28 of Figure 2A; Specification page 12, line 9 - line 12).

The vendor's web site may receive the one or more user selections for the customized computer system or measurement system (30 of Figure 2A, Specification page 12, line 12 - line 20) and may, in response, send data and information to the client computer system using dynamic web page generation technology to visually depict the current or final 'as purchased' customized computer system or measurement system (32/34 of Figure 2A, Specification page 13, line 3 – page 14, line 2; Figures 4 and 6, Specification page 11, line 13 – page 12, line 8). The user may verify the visually depicted customized computer system or measurement system for accuracy, completeness, etc. prior to proceeding with payment and final check out.

## **VI. ISSUES**

1. Whether claims 89-98, 100-103, 106, 108-121, 123-126, 129-131, 133, and 134 are unpatentable under 35 U.S.C. § 103(a) over Henson (U.S. Patent No. 6,167,383) in view of Motomiya et al. (U.S. Patent No. 6,083,267), and further in view of Risk (U.S. Patent No. 5,673,434).

2. Whether claims 89-134 are unpatentable under 35 U.S.C. § 103(a) over Henson (U.S. Patent No. 6,167,383) in view of Barad et al. (U.S. Patent No. 6,206,705 B1), and further in view of Risk (U.S. Patent No. 5,673,434) and IEEE Spectrum.

## **VII. GROUPING OF CLAIMS**

The claims do not stand or fall together. The following ten groups are separately patentable:

1. Claims 89, 90, 91, 92, 94, 95, 96, 97, 100, 101, 102, 105, 106, 107, 109, 123, 124, 125, and 133 stand or fall together.
2. Claim 93 stands or falls by itself.
3. Claims 98, 99, and 104 stand or fall together.
4. Claims 103 and 108 stand or fall together.
5. Claim 110 stands or falls by itself.
6. Claims 111, 112, 113, 114, 117, 118, 119, 121, 128, 129, 131, and 134 stand or fall together.
7. Claim 115 stands or falls by itself.
8. Claims 120 and 122 stand or fall together.
9. Claims 126 and 130 stand or fall together.
10. Claim 132 stands or falls by itself.

The reasons why the ten groups of claims are believed to be separately patentable are explained below in the Argument.

## VIII. ARGUMENT

1. **Claim Group 1: Claims 89, 90, 91, 92, 94, 95, 96, 97, 100, 101, 102, 105, 106, 107, 109, 123, 124, 125, and 133**

**A. Section 103(a) Rejection over Henson in view of Motomiya, and further in view of Risk**

Claims 89, 90, 91, 92, 94, 95, 96, 97, 100, 101, 102, 105, 106, 107, 109, 123, 124, 125, and 133 stand twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Motomiya et al. (U.S. Patent No. 6,083,267, henceforth Motomiya), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk).

**B. Section 103(a) Rejection over Henson in view of Barad, and further in view of Risk**

Additionally, claims 89, 90, 91, 92, 94, 95, 96, 97, 100, 101, 102, 105, 106, 107, 109, 123, 124, 125, and 133 stand twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Barad et al. (U.S. Patent No. 6,206,705 B1, henceforth Barad), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk) and IEEE Spectrum.

Claim 89 will be addressed in depth in the following argument. The arguments and issues related to Rejections A and B are similar, differing only as regards Motomiya and Barad. Thus, for brevity, the below arguments are directed to both Rejections except where indicated by specific reference to the Motomiya and Barad references.

**The cited references fail to teach or suggest every element of claim 89 (and similarly, independent claim 133).**

In the Office Action of March 31, 2004, the Examiner asserts that Henson teaches all of the elements of Appellant's claim 89 except for the customizable product being a

measurement system (Office Action, p. 3), and providing an image of the configured system to the client system for display, wherein the image of the configured system visually depicts the customizable component selections of the user. The Examiner further asserts that a computer system is an art recognized equivalent for a measurement system, citing Mitchell's (U.S. Patent 5,710,727) and IEEE Spectrum's description of virtual instrumentation systems.

Henson discloses a method for providing customer configured machines at an Internet site. Henson in the abstract does teach a web-based online store including a configurator, a cart, a checkout, a database, and a user interface enabling a custom configuration of a computer system. However, Henson does not teach or suggest *providing an image of the configured measurement system to the client system for display, wherein the image of the configured measurement system visually depicts the customizable component selections of the user*, as the Examiner had admitted in the Office Action.

The Examiner asserts that a speaker is inherently a measurement device, since it includes a transducer, and converts electrical energy into acoustic energy, and thus, that a standard personal computer with a speaker is a measurement system. Appellant respectively suggests that such a computer absent some type of measurement software, such as a measurement application program or instrument driver, and/or measurement hardware, such as a data acquisition (DAQ) expansion card, signal generator, etc., is not properly a measurement system, as would be recognized by those skilled in the art of measurement systems. The cited Mitchell and IEEE Spectrum references teach virtual instruments (based on computers). However, Appellant notes that such virtual instruments still require measurement-related software and/or hardware to perform measurement functions. In other words, while a standard personal computer may be used to create or build a measurement system, additional software and/or hardware components specific to the measurement domain are required for the system to be a measurement system.

Appellant notes that even if a user were to use Henson's system to configure a computer system, the configured computer system would not be a configured measurement system, and so additional configuration would still be required, e.g., to add measurement

related software and/or hardware. Thus, the problem of configuring a computer system is not the same as that of configuring a measurement system.

Appellant respectfully submits that the Examiner is incorrect in his characterization of Mitchell's and IEEE Spectrums teachings. Mitchell does not equate a computer system with a measurement system, but rather describes "virtual instrumentation" that uses a computer system as a component. As Mitchell states in column 1, lines 66 – column 2, line 2, "Virtual instrumentation comprises general purpose personal computers and workstations combined with instrumentation software and hardware to build a complete instrumentation system". Similarly, the IEEE Spectrum reference refers to "integrating PCs with instruments through plug-in boards" to develop computer-based instrumentation systems. In other words, a computer system, absent the necessary measurement software and hardware specific to measurement operations, is specifically *not* a measurement system. Nowhere does Henson teach, suggest, or even hint, at measurement software or hardware comprised in or coupled to the computer systems described therein.

Moreover, Henson does not teach or suggest "receiving a request from a user of the client system to configure the measurement system, wherein the measurement system includes one or more customizable components, *wherein at least one of the customizable components is a measurement device*", nor " providing customizable component options of the customizable components [including the measurement device] to the client system for display after receiving said request", nor "receiving customizable component selections for at least one of the one or more customizable components of the measurement system in response to user input, wherein the customizable component selections applied to the measurement system specify *a configured measurement system*".

Thus, neither Henson nor the IEEE Spectrum reference teaches or suggests online configuration of a measurement system, nor does either reference teach or suggest providing an image of the configured measurement system to the client system for display, wherein the image of the configured measurement system visually depicts the customizable component selections of the user.

The Examiner admits that Henson fails to teach displaying an image of the customized product (i.e., the measurement system) to the client system wherein the image of the customized product visually depicts the customizable component selections of the user, but erroneously asserts that Motomiya provides this missing feature, and further asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Motomiya into the method and system of Henson, and that such a combination produces Appellant's invention as represented in claim 89. Appellant respectfully submits that Motomiya, like Henson, fails to teach this feature of claim 89.

Per *In re Oetiker*, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992): The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself.

Additionally, per *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Appellant notes that Motomiya teaches a method for designing jewelry, such as a necklace or a bracelet. Motomiya teaches display of a multiplicity of photographic images of various jewelry components, from which the user may select desired jewelry components to design a necklace or bracelet.

In addition, Motomiya in column 3, line 65 through column 4, line 4 teaches system with:

“a multitude of photographic images of the various parts making up the accessory constituting the particular commodity to enable the customer to design it by himself/herself.”

In column 4, lines 30-44, Motomiya teaches that:

“the material, the color and the length of the equipment, the color of the fasteners and the color of the beads are presented for selection as parts required for designing the necklace or the bracelet.”

In other words, Motomiya teaches selection of accessories for a jewelry item being designed such as a bracelet or necklace.

Similarly, the Examiner admits that Henson fails to teach displaying an image of the customized product (i.e., the measurement system) to the client system wherein the image of the customized product visually depicts the customizable component selections of the user, but erroneously asserts that Barad provides this missing feature. Appellant respectfully submits that Barad, like Henson, fails to teach this feature of claim 89.

Appellant notes that Barad teaches a method for designing toys, such as dolls. Barad teaches display of various configurable toy components or accessories, from which the user may select and configure desired components to design a personalized toy, such as a doll.

In addition, Barad in column 1, lines 29 - 31 teaches a system that:

“allows a user to create a personalized toy through interactive computer programs, receiving immediate feedback on changes made to the toy.”

In column 3, lines 36-41, Barad states:

“...it should be understood that, while the present invention is described with respect to a doll and its clothing, it is intended that the invention include a method to make many other types of personalized toys, such as toy vehicles, race sets, construction sets, and games”

In other words, Barad teaches selection and configuration of accessories for personalized toys, such as a personalized doll.

Thus, Appellant respectfully submits that the jewelry design taught in Motomiya, and the toy design taught in Barad are each significantly different from *configuring a measurement system*. Hence neither Motomiya nor Barad teaches or suggests configuring a measurement system, and specifically does not teach or suggest “providing

an image of the *configured measurement system* to the client system for display, wherein the image of the *configured measurement system* visually depicts the customizable component selections of the user”.

“In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oeticker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Certain of the presented claims are directed at measurement and measurement systems, and the particular problem addressed is the configuration of measurement systems. “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). Here, both Motomiya and Barad are clearly not in the field of Applicants’ endeavor. The present claims deal with measurement systems and computer systems, and the configuration thereof. In contrast, Motomiya deals with jewelry design, and Barad deals with toy design. Furthermore, the subjects of Motomiya or Barad would not logically have commended itself to an inventor’s attention when considering the problem addressed by the claimed invention. One of skill in the art seeking to address the problem of configuring measurement systems would not have any logical reasons for considering a technique used to design or configure jewelry or toys. Thus, neither Motomiya nor Barad is within Applicants’ field of endeavor and are thus not pertinent to the problem addressed by Appellant’s invention. Accordingly, Motomiya and Barad are both non-analogous art and cannot properly be used to reject Appellant’s claims.

The Examiner states that online configuration of jewelry (Motomiya) is pertinent to the particular problem with which the Appellant was concerned, that is, the online configuration of measurement systems. The Examiner has clearly over-generalized the particular problem with which the inventors were concerned. *In re Oeticker* refers to the particular problem, not the general problem. The analogous art requirement can always be made meaningless by over-generalizing the problem. Almost any art may be

considered pertinent if the problem is stated in general enough terms. That is why the courts have insisted that art use in § 103 rejections be pertinent to the particular problem. For many of the presented claims, the particular problem with which the inventors were concerned pertains to online configuration of measurement systems. Motomiya is clearly not pertinent to this particular problem. Similar arguments apply to Barad.

Moreover, neither Henson nor Motomiya provides a motivation to combine. In fact, the only suggestion of motivation to combine asserted by the Examiner is “to provide the customer with a more natural and easier-to-use design interface”, thus simply citing an improved result based on hindsight analysis of Appellant’s system as claimed. Thus, for at least the reasons provided above, Appellant respectfully submits that Henson and Motomiya, taken individually or in combination, fail to teach or suggest every element of Appellant’s claim 89. Claim 133 includes similar limitations as claim 89, and so the arguments above apply with equal force to that claim.

Similarly, neither Henson nor Barad provides a motivation to combine. The only suggestion of motivation to combine asserted by the Examiner is “to provide the customer of Henson’s system and method with a visual display of the custom configured product”. Appellant submits that this is simply citing an improved result based on hindsight analysis of Appellant’s system as claimed. Thus, for at least the reasons provided above, Appellant respectfully submits that Henson and Barad, taken individually or in combination, fail to teach or suggest every element of Appellant’s claim 89. Claim 133 includes similar limitations as claim 89, and so the arguments above apply with equal force to that claim.

The Examiner further argues that several of Appellant’s dependent claims are obvious (Office Action, pp. 5-6). Appellant’s arguments as set forth above support in equal measure the allowability of the dependent claims. Furthermore, the Examiner’s assertions concerning the teachings of Henson and Motomiya with regard to the dependent claims are similarly unsupported by the texts and illustrations of the two references, as are the Examiner’s assertions concerning the teachings of Henson and Barad with regard to the dependent claims.

Therefore, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to combine Henson and Motomiya in order to obtain the benefits provided by Appellant's claimed invention.

For the reasons given above, Appellant asserts that the Examiner has failed to establish a prima facie case of obviousness. Thus, claims 89, 90, 91, 92, 94, 95, 96, 97, 100, 101, 102, 105, 106, 107, 109, 123, 124, 125, and 133 are patentable over Henson in view of Motomiya, and further in view of Risk.

Similarly, Appellants submit that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to combine Henson and Barad in order to obtain the benefits provided by Appellant's claimed invention.

For the reasons given above, Appellant asserts that the Examiner has failed to establish a prima facie case of obviousness. Thus, claims 89, 90, 91, 92, 94, 95, 96, 97, 100, 101, 102, 105, 106, 107, 109, 123, 124, 125, and 133 are patentable over Henson in view of Barad, and further in view of Risk and IEEE Spectrum.

## **2. Claim Group 2: Claim 93**

### **A. Section 103(a) Rejection of Claim 93 over Henson in view of Motomiya, and further in view of Risk**

Claim 93 stands twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Motomiya et al. (U.S. Patent No. 6,083,267, henceforth Motomiya), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk).

### **B. Section 103(a) Rejection of Claim 93 over Henson in view of Barad, and further in view of Risk and IEEE Spectrum**

Claim 93 stands twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Barad et al. (U.S. Patent

No. 6,206,705 B1, henceforth Barad), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk) and IEEE Spectrum.

Appellant submits that claim 93 is separately patentable because the prior art does not suggest the limitations recited in this claim.

In addition to the limitations of independent claim 89, claim 93 includes the limitation: “wherein said providing the image of the configured measurement system includes providing text corresponding to the customizable component selections of the user, wherein the text is visually depicted proximate to respective locations of the customizable components comprised in the image of the configured measurement system”.

The Examiner admits that Henson and Motomiya fail to teach providing text corresponding to the customizable component selections of the user, or that the text is visually depicted proximate to respective locations of the customizable components comprised in the image of the configured product, but asserts that Risk reaches these limitations, citing Figure 2 and column 1, lines 22-29.

Similarly, the Examiner admits that Henson and Barad fail to teach providing text corresponding to the customizable component selections of the user, or that the text is visually depicted proximate to respective locations of the customizable components comprised in the image of the configured product, but asserts that Risk reaches these limitations, also citing Figure 2 and column 1, lines 22-29.

Appellant notes that Risk teaches a customizable “solid” necktie that may include writing on elements of the tie, and that Risk specifically does not teach online configuration of a measurement system, and in fact, does not teach or describe online configuration at all. Appellant respectfully submits that the citation of a possibly lettered or otherwise decorated mechanical necktie with respect to the present case is improper.

As described in the cited passage of Risk (and illustrated in Figure 2), “The adorning characteristic may take the form of a solid color tie of a same or contrasting color as the remainder of the wearer’s apparel. It may also be provided with designs,

writing and/or other indicia, *again for adornment purposes* or, in the alternative, for the statement of a message through the design or writing. Such message might be the advocating of a personal position of the wearer, support for an athletic team, an advertisement, or the like.”

In contrast, in the embodiment of Appellants system represented in claim 93, the text *corresponds to the customizable component selections of the user*. In other words, as the specification of the present application makes clear, the text displayed is for identification or description of the customizable components, and is specifically not for adornment on the components themselves, as in the system of Risk.

The Examiner’s assertion that “Appellant’s use of text on the customizable component is used for adornment purposes since the text does not affect the component in any way” appears to confuse Risk’s use of adorning text on the tie’s components themselves with the use of informative text displayed in an *image of a measurement system*, where the displayed text is clearly functional in the described system and method, since the text identifies or explains the customizable component selections of the user to facilitate the user’s configuration of the measurement system, and is thus specifically *not* for adornment purposes. Appellant further notes that in the invention as represented in claim 93, the text is *not* displayed on the actual components, as it is in Risk.

Thus, the novelty tie design taught in Risk is significantly different from *configuring a measurement system*. Hence Risk does not teach nor suggest configuring a measurement system, does not teach providing an image at all, and specifically does not teach or suggest “wherein said providing the image of the configured measurement system includes providing text corresponding to the customizable component selections of the user, wherein the text is visually depicted proximate to respective locations of the customizable components comprised in the image of the configured measurement system”.

“In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.”

*In re Oeticker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Certain of the presented claims are directed at measurement and measurement systems, and the particular problem addressed is the configuration of measurement systems. "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). Here, Risk is clearly not in the field of Applicants' endeavor. Many of the present claims deal with measurement systems, and the configuration thereof. In contrast, Risk deals with novelty tie design. Furthermore, the subject of Risk would not logically have commended itself to an inventor's attention when considering the problem addressed by the claimed invention. One of skill in the art seeking to address the problem of configuring measurement systems would not have any logical reasons for considering a technique used to design or configure novelty ties. Thus, Risk is not within Applicants' field of endeavor and is not pertinent to the problem addressed by Applicants' invention. Accordingly, Risk is non-analogous art and cannot properly be used to reject Appellant's claims.

Moreover, neither Henson, nor Motomiya, nor Risk provides a motivation to combine. In fact, the only suggestion of motivation to combine asserted by the Examiner is "to allow a user to personalize the product", thus merely citing an improved result based on hindsight analysis of Appellant's system as claimed. Thus, for at least the reasons provided above, Appellant respectfully submits that Henson, Motomiya, and Risk, taken individually or in combination, fail to teach or suggest every element of Appellant's claim 93.

Additionally, neither Henson, nor Barad, nor Risk provides a motivation to combine. The only suggestion of motivation to combine asserted by the Examiner is "to allow a user to personalize the product", thus merely citing an improved result based on hindsight analysis of Appellant's system as claimed. Thus, for at least the reasons provided above, Appellant respectfully submits that Henson, Barad, and Risk, taken individually or in combination, fail to teach or suggest every element of Appellant's claim 93.

Furthermore, the arguments presented above regarding claim 89 apply with equal force to claim 93. In light of all the arguments set forth above, the Examiner's rejection of claim 93 is erroneous.

**3. Claim Group 3: Claims 98, 99, and 104**

**A. Section 103(a) Rejection of Claims 98, 99, and 104 over Henson in view of Motomiya, and further in view of Risk**

Claims 98, 99, and 104 stand twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Motomiya et al. (U.S. Patent No. 6,083,267, henceforth Motomiya), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk).

**B. Section 103(a) Rejection of Claims 98, 99, and 104 over Henson in view of Barad, and further in view of Risk and IEEE Spectrum**

Claims 98, 99, and 104 stand twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Barad et al. (U.S. Patent No. 6,206,705 B1, henceforth Barad), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk) and IEEE Spectrum.

In addition to the limitations of independent claim 89, claim 98 includes the limitations: "wherein said providing the one or more customizable component options of the measurement system includes providing an image of the measurement system to the client system for display, wherein images of at least a subset of the one or more customizable components form at least a portion of the image of the measurement system," and "wherein said receiving customizable component selections includes: receiving user input selecting an image of a first customizable component displayed in the image of the measurement system, wherein said receiving user input selecting the image of the first customizable component operates to select the first customizable component for configuration, and receiving user input selecting a first customizable component option for the first customizable component, wherein the user input selecting

the first customizable component option comprises the customizable component selection for the first customizable component.”

Claim 99, dependent from claim 98, includes the further limitation, “wherein said receiving user input selecting the image of the first customizable component further includes: receiving user input indicating a position of a cursor of the client system overlaps the location of the image of the first customizable component displayed in the image of the measurement system.”

Claim 104, dependent from claim 98 includes the further limitation, “wherein said receiving customizable component selections further includes: providing a sequence of images corresponding to the customizable component options of the first customizable component after said receiving user input selecting the image of the first customizable component.”

Thus, the above claims represent an embodiment where an image of the system that includes images of various customizable components is presented to the user. The user may then select a customizable component image in the system image e.g., with a pointing device, such as a mouse, to initiate configuration of that customizable component. Thus, images of the components (contained in the image of the system being configured) are themselves the items selected by the user to begin the configuration process for the respective components. This feature of the invention provides a much more intuitive way for the user to interact with the system being designed, i.e., the user can select customizable components directly in the image of the system being designed.

Appellant submits that neither Henson, Motomiya, nor Risk includes these limitations. For example, Henson does not provide an image of the system that includes customizable component images that are selectable by a user to initiate configuration of the corresponding component, and Risk does not mention or even hint at e-commerce or presenting an image of the product to a user. Motomiya does disclose providing an image of jewelry as it is being configured. However, this image is not used at all for selecting customizable component options. Motomiya also provides images of customizable components. However, in Motomiya these images are NOT contained within the image of the jewelry item being configured.

Rather, in the system of Motomiya, the user selects customizable components by clicking on a category button separate and apart from the image of the jewelry item being configured. The category button may comprise, e.g., a “fasteners” button, “beads” button, or “equipment” button, which invokes a palette of component images from which the user then selects and configures, as illustrated in Figures 5A, 5B, and 6A, and described in column 4, line 28 through column 6, line 28. For example, when the user clicks on a fastener from the fastener palette, the selected fastener automatically replaces the previous fastener in the product image. While Motomiya does allow the user to click on the components included in the product image, this is only to rearrange or remove the components in or from the product image (see column 6, lines 7-9), NOT to select a component for configuration. The various component configuration options are displayed not on the product image, but rather in palettes or display areas distinct from the product image, e.g., color’s displayed around the beads button (Figures 5A, 5B, 6A, and 6B), fasteners displayed in a fasteners palette (Figure 5B), and so forth. Thus, the user does not select the customizable component for configuration from the product image.

Similarly, Barad does teach the display of the configured product in accordance with user-selected component configurations. In other words, Barad teaches showing an image of the product during configuration. However, Barad fails to teach selecting customizable components for configuration from the product image. Rather in Barad’s system, options for component configuration are displayed separately from the configured product image, e.g., as groups or palettes of icons or images illustrating the component options. For example, as shown in Figure 7, various hairstyles, skin-tones, and eye colors are selectable from corresponding groups of icons or buttons, in response to which the product image is automatically updated to reflect the selected component options. As another example, Figure 17 illustrates display of various hair colors for the doll, again, displayed separately from the product image, from which the user may select to configure the doll’s hair color. Thus, the user specifically does not select the customizable component for configuration from the product image itself.

Thus, both Motomiya and Barad fail to teach *receiving user input selecting an image of a first customizable component displayed in the image of the measurement*

*system, and receiving user input selecting a first customizable component option for the first customizable component. More specifically, both Motomiya and Barad fail to teach wherein the user input selecting the first customizable component option comprises the customizable component selection for the first customizable component.*

Neither does Motomiya or Barad teach or suggest *providing a sequence of images corresponding to the customizable component options of the first customizable component after said receiving user input selecting the image of the first customizable component* (which is included in the product image).

Thus neither Motomiya nor Barad teaches or suggests the limitations of claims 98, 99, or 104.

Moreover, as argued above, neither Henson, nor Motomiya, nor Risk provides a motivation to combine, nor does Henson, Barad, or Risk.

Furthermore, the arguments presented above regarding claim 89 apply with equal force to claims 98, 99, and 104. In light of all the arguments set forth above, the Examiner's rejection of claims 98, 99, and 104 is erroneous.

#### **4. Claim Group 4: Claims 103 and 108**

##### **A. Section 103(a) Rejection of Claims 103 and 108 over Henson in view of Motomiya, and further in view of Risk**

Claims 103 and 108 stand twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Motomiya et al. (U.S. Patent No. 6,083,267, henceforth Motomiya), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk).

##### **B. Section 103(a) Rejection of Claims 103 and 108 over Henson in view of Barad, and further in view of Risk and IEEE Spectrum**

Claims 103 and 108 stand twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Barad

et al. (U.S. Patent No. 6,206,705 B1, henceforth Barad), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk) and IEEE Spectrum.

Claim 103 includes the limitation: “wherein the menu is operable to be displayed proximate to the location of the image of the first customizable component”, where the menu comprises the customizable component options of the first customizable component.

Claim 108 includes the limitation: “the client system displaying the image of the configured measurement system in response to said providing the one or more customizable component options of the customizable components to the client system, wherein images of at least a subset of the one or more customizable components are displayed in the image of the configured measurement system, wherein, for each customizable component, the one or more customizable component options are displayed proximate to the image of the customizable component”.

Claims 103 and 108 are separately patentable because the prior art does not suggest the limitations recited in these claims. As noted above, neither Henson nor Risk teaches display of a configured product at all, and so the below arguments are directed to Motomiya and Barad. For example, neither Motomiya nor Barad teaches displaying a menu proximate to the location of the image of the first customizable component, where the menu comprises the customizable component options of the first customizable component. Similarly, neither Motomiya nor Barad teaches displaying the image of the configured measurement system where images of at least a subset of the customizable components are displayed in the image, and where, for each customizable component, the customizable component options are displayed proximate to the image of the customizable component. Rather, in both Motomiya and Barad, the customizable component options are displayed in respective areas or palettes separate and distinct from the configured product image, and are specifically *not* displayed proximate to the respective images of the customizable components.

Thus neither Motomiya nor Barad teaches or suggests the limitations of claims 103 or 108.

Moreover, as argued above, neither Henson, nor Motomiya, nor Risk provides a motivation to combine, nor does Henson, Barad, or Risk.

Furthermore, the arguments presented above regarding claim 89 apply with equal force to claims 103 and 108. In light of all the arguments set forth above, the Examiner's rejection of claims 103 and 108 is erroneous.

**5. Claim Group 5: Claim 110**

**A. Section 103(a) Rejection of Claim 110 over Henson in view of Motomiya, and further in view of Risk**

Claim 110 stands twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Motomiya et al. (U.S. Patent No. 6,083,267, henceforth Motomiya), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk).

**B. Section 103(a) Rejection of Claim 110 over Henson in view of Barad, and further in view of Risk and IEEE Spectrum**

Claim 110 stands twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Barad et al. (U.S. Patent No. 6,206,705 B1, henceforth Barad), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk) and IEEE Spectrum.

Appellant submits that claim 110 is separately patentable because the prior art does not suggest the limitations recited in this claim.

Claim 110 includes the limitation: "wherein the customizable component selections include one or more of: measurement card; cable, signal conditioning modules and transducer."

Claim 110 is separately patentable because the prior art does not suggest the limitations recited in this claim. As noted above, neither Henson nor Risk teaches display of a configured product at all, and so the below arguments are directed to Motomiya and Barad. For example, neither Motomiya nor Barad teaches or suggests a measurement system, and specifically does not teach or suggest configurable system components that are measurement devices, such as a measurement card, cable, signal conditioning modules, or transducer. Rather, Motomiya and Barad relate to jewelry and toys, respectively.

Thus neither Motomiya nor Barad teaches or suggests the limitations of claim 110.

Moreover, as argued above, neither Henson, nor Motomiya, nor Risk provides a motivation to combine, nor does Henson, Barad, or Risk.

Furthermore, the arguments presented above regarding claim 89 apply with equal force to claim 110. In light of all the arguments set forth above, the Examiner's rejection of claim 110 is erroneous.

**6. Claim Group 6: Claims 111, 112, 113, 114, 117, 118, 119, 121, 128, 129, 131, and 134**

**A. Section 103(a) Rejection over Henson in view of Motomiya, and further in view of Risk**

Claims 111, 112, 113, 114, 117, 118, 119, 121, 128, 129, 131, and 134 stand twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Motomiya et al. (U.S. Patent No. 6,083,267, henceforth Motomiya), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk).

**B. Section 103(a) Rejection over Henson in view of Barad, and further in view of Risk**

Additionally, claims 111, 112, 113, 114, 117, 118, 119, 121, 128, 129, 131, and 134 stand twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Barad et al. (U.S. Patent No. 6,206,705 B1, henceforth Barad), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk) and IEEE Spectrum.

Claim 111 will be addressed in depth in the following argument. The arguments and issues related to Rejections A and B are similar, differing only as regards Motomiya and Barad. Thus, for brevity, the below arguments are directed to both Rejections except where indicated by specific reference to the Motomiya and Barad references.

**The cited references fail to teach or suggest every element of claim 111 (and similarly, independent claim 134).**

In the Office Action of March 31, 2004, the Examiner asserts that Henson teaches all of the elements of Appellant's claim 111 except for providing an image of the configured system to the client system for display, wherein the image of the configured system visually depicts the customizable component selections of the user.

Henson discloses a method for providing customer configured machines at an Internet site. Henson in the abstract does teach a web-based online store including a configurator, a cart, a checkout, a database, and a user interface enabling a custom configuration of a computer system. However, Henson does not teach or suggest *providing an image of the configured computer system to the client system for display, wherein the image of the configured computer system visually depicts the customizable component selections of the user*, as the Examiner had admitted in the Office Action.

Moreover, Henson does not teach or suggest "receiving a request from a user of the client system to configure the computer system, wherein the computer system includes one or more customizable components", nor "providing customizable component options of the customizable components to the client system for display after receiving said request", nor "receiving customizable component selections for at least one of the one or more customizable components of the computer system in response to user input, wherein the

customizable component selections applied to the computer system specify *a configured computer system*".

The Examiner admits that Henson fails to teach providing and displaying an image of the customized product (i.e., the computer system) to the client system, wherein the image of the customized product visually depicts the customizable component selections of the user, but erroneously asserts that Motomiya provides this missing feature, and further asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Motomiya into the method and system of Henson, and that such a combination produces Appellant's invention as represented in claim 110. Appellant respectfully submits that Motomiya, like Henson, fails to teach this feature of claim 110.

As noted above, per *In re Oetiker*, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992): The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself.

Additionally, per *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Appellant notes that Motomiya teaches a method for designing jewelry, such as a necklace or a bracelet. Motomiya teaches display of a multiplicity of photographic images of various jewelry components, from which the user may select desired jewelry components to design a necklace or bracelet.

In addition, Motomiya in column 3, line 65 through column 4, line 4 teaches system with:

“a multitude of photographic images of the various parts making up the accessory constituting the particular commodity to enable the customer to design it by himself/herself.”

In column 4, lines 30-44, Motomiya teaches that:

“the material, the color and the length of the equipment, the color of the fasteners and the color of the beads are presented for selection as parts required for designing the necklace or the bracelet.”

In other words, Motomiya teaches selection of accessories for a jewelry item being designed such as a bracelet or necklace.

Similarly, the Examiner admits that Henson fails to teach displaying an image of the customized product (i.e., the computer system) to the client system wherein the image of the customized product visually depicts the customizable component selections of the user, but erroneously asserts that Barad provides this missing feature. Appellant respectfully submits that Barad, like Henson, fails to teach this feature of claim 110.

As noted above, Barad teaches a method for designing toys, such as dolls. Barad teaches display of a various configurable toy components or accessories, from which the user may select and configure desired components to design a personalized toy, such as a doll.

In addition, Barad in column 1, lines 29 - 31 teaches a system that:

“allows a user to create a personalized toy through interactive computer programs, receiving immediate feedback on changes made to the toy.”

In column 3, lines 36-41, Barad states:

“...it should be understood that, while the present invention is described with respect to a doll and its clothing, it is intended that the invention include a method to make many other types of personalized toys, such as toy vehicles, race sets, construction sets, and games”

In other words, Barad teaches selection and configuration of accessories for personalized toys, such as a personalized doll.

Thus, Appellant respectfully submits that the jewelry design taught in Motomiya, and the toy design taught in Barad are each significantly different from *configuring a computer system*. Hence neither Motomiya nor Barad teaches or suggests configuring a computer system, and specifically does not teach or suggest “providing an image of the *configured computer system* to the client system for display, wherein the image of the *configured computer system* visually depicts the customizable component selections of the user”.

“In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oeticker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Certain of the presented claims are directed at measurement and computer systems, and the particular problem addressed is the configuration of computer systems. “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). Here, both Motomiya and Barad are clearly not in the field of Applicants’ endeavor. The present claims deal with computer systems and computer systems, and the configuration thereof. In contrast, Motomiya deals with jewelry design, and Barad deals with toy design. Furthermore, the subjects of Motomiya or Barad would not logically have commended itself to an inventor’s attention when considering the problem addressed by the claimed invention. One of skill in the art seeking to address the problem of configuring computer systems would not have any logical reasons for considering a technique used to design or configure jewelry or toys. Thus, neither Motomiya nor Barad is within Applicants’ field of endeavor and are thus not pertinent to the problem addressed by Appellant’s invention. Accordingly, Motomiya and Barad are both non-analogous art and cannot properly be used to reject Appellant’s claims.

The Examiner states that online configuration of jewelry (Motomiya) is pertinent to the particular problem with which the Appellant was concerned, that is, the online configuration of computer systems. The Examiner has clearly over-generalized the particular problem with which the inventors were concerned. *In re Oeticker* refers to the particular problem, not the general problem. The analogous art requirement can always be made meaningless by over-generalizing the problem. Almost any art may be considered pertinent if the problem is stated in general enough terms. That is why the courts have insisted that art use in § 103 rejections be pertinent to the particular problem. For many of the presented claims, the particular problem with which the inventors were concerned pertains to online configuration of computer systems. Motomiya is clearly not pertinent to this particular problem. Similar arguments apply to Barad.

Moreover, neither Henson nor Motomiya provides a motivation to combine. In fact, the only suggestion of motivation to combine asserted by the Examiner is “to provide the customer with a more natural and easier-to-use design interface”, thus simply citing an improved result based on hindsight analysis of Appellant’s system as claimed. Thus, for at least the reasons provided above, Appellant respectfully submits that Henson and Motomiya, taken individually or in combination, fail to teach or suggest every element of Appellant’s claim 110. Claim 134 includes similar limitations as claim 110, and so the arguments above apply with equal force to that claim.

Similarly, neither Henson nor Barad provides a motivation to combine. As noted above, the only suggestion of motivation to combine asserted by the Examiner is “to provide the customer of Henson’s system and method with a visual display of the custom configured product”. Appellant submits that this is simply citing an improved result based on hindsight analysis of Appellant’s system as claimed. Thus, for at least the reasons provided above, Appellant respectfully submits that Henson and Barad, taken individually or in combination, fail to teach or suggest every element of Appellant’s claim 110. Claim 134 includes similar limitations as claim 110, and so the arguments above apply with equal force to that claim.

The Examiner further argues that several of Appellant’s dependent claims are obvious (Office Action, pp. 5-6). Appellant’s arguments as set forth above support in equal

measure the allowability of the dependent claims. Furthermore, the Examiner's assertions concerning the teachings of Henson and Motomiya with regard to the dependent claims are similarly unsupported by the texts and illustrations of the two references, as are the Examiner's assertions concerning the teachings of Henson and Barad with regard to the dependent claims.

Therefore, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to combine Henson and Motomiya in order to obtain the benefits provided by Appellant's claimed invention.

For the reasons given above, Appellant asserts that the Examiner has failed to establish a prima facie case of obviousness. Thus, claims 111, 112, 113, 114, 117, 118, 119, 121, 128, 129, 131, and 134 are patentable over Henson in view of Motomiya, and further in view of Risk.

Similarly, Appellants submit that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to combine Henson and Barad in order to obtain the benefits provided by Appellant's claimed invention.

For the reasons given above, Appellant asserts that the Examiner has failed to establish a prima facie case of obviousness. Thus, claims 111, 112, 113, 114, 117, 118, 119, 121, 128, 129, 131, and 134 are patentable over Henson in view of Barad, and further in view of Risk and IEEE Spectrum.

## **7. Claim Group 7: Claim 115**

### **A. Section 103(a) Rejection of Claim 115 over Henson in view of Motomiya, and further in view of Risk**

Claim 115 stands twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Motomiya et al. (U.S. Patent No. 6,083,267, henceforth Motomiya), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk).

**B. Section 103(a) Rejection of Claim 115 over Henson in view of Barad, and further in view of Risk and IEEE Spectrum**

Claim 115 stands twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Barad et al. (U.S. Patent No. 6,206,705 B1, henceforth Barad), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk) and IEEE Spectrum.

Appellant submits that claim 115 is separately patentable because the prior art does not suggest the limitations recited in this claim.

In addition to the limitations of independent claim 111, claim 115 includes the limitation: “wherein said providing the image of the configured computer system includes providing text corresponding to the customizable component selections of the user, wherein the text is visually depicted proximate to respective locations of the customizable components comprised in the image of the configured computer system”.

The Examiner admits that Henson and Motomiya fail to teach providing text corresponding to the customizable component selections of the user, or that the text is visually depicted proximate to respective locations of the customizable components comprised in the image of the configured product, but asserts that Risk reaches these limitations, citing Figure 2 and column 1, lines 22-29.

Similarly, the Examiner admits that Henson and Barad fail to teach providing text corresponding to the customizable component selections of the user, or that the text is visually depicted proximate to respective locations of the customizable components comprised in the image of the configured product, but asserts that Risk reaches these limitations, also citing Figure 2 and column 1, lines 22-29.

As Appellant noted above, Risk teaches a customizable “solid” necktie that may include writing on elements of the tie, and that Risk specifically does not teach online configuration of a computer system, and in fact, does not teach or describe online

configuration at all. Appellant respectfully submits that the citation of a possibly lettered or otherwise decorated mechanical necktie with respect to the present case is improper.

As described in the cited passage of Risk (and illustrated in Figure 2), “The adorning characteristic may take the form of a solid color tie of a same or contrasting color as the remainder of the wearer’s apparel. It may also be provided with designs, writing and/or other indicia, *again for adornment purposes* or, in the alternative, for the statement of a message through the design or writing. Such message might be the advocating of a personal position of the wearer, support for an athletic team, an advertisement, or the like.”

In contrast, in the embodiment of Appellants system represented in claim 115, the text *corresponds to the customizable component selections of the user*. In other words, as the specification of the present application makes clear, the text displayed is for identification or description of the customizable components, and is specifically not for adornment on the components themselves, as in the system of Risk.

The Examiner’s assertion that “Appellant’s use of text on the customizable component is used for adornment purposes since the text does not affect the component in any way” appears to confuse Risk’s use of adorning text on the tie’s components themselves with the use of informative text displayed in an *image of a computer system*, where the displayed text is clearly functional in the described system and method, since the text identifies or explains the customizable component selections of the user to facilitate the user’s configuration of the computer system, and is thus specifically *not* for adornment purposes. Appellant further notes that in the invention as represented in claim 115, the text is *not* displayed on the actual components, as it is in Risk.

Thus, the novelty tie design taught in Risk is significantly different from *configuring a computer system*. Hence Risk does not teach nor suggest configuring a computer system, does not teach providing an image at all, and specifically does not teach or suggest “wherein said providing the image of the configured computer system includes providing text corresponding to the customizable component selections of the user, wherein the text is visually depicted proximate to respective locations of the customizable components comprised in the image of the configured computer system”.

“In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oeticker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Certain of the presented claims are directed at measurement and computer systems, and the particular problem addressed is the configuration of computer systems. “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). Here, Risk is clearly not in the field of Applicants’ endeavor. Many of the present claims deal with computer systems, and the configuration thereof. In contrast, Risk deals with novelty tie design. Furthermore, the subject of Risk would not logically have commended itself to an inventor’s attention when considering the problem addressed by the claimed invention. One of skill in the art seeking to address the problem of configuring computer systems would not have any logical reasons for considering a technique used to design or configure novelty ties. Thus, Risk is not within Applicants’ field of endeavor and is not pertinent to the problem addressed by Applicants’ invention. Accordingly, Risk is non-analogous art and cannot properly be used to reject Appellant’s claims.

Moreover, neither Henson, nor Motomiya, nor Risk provides a motivation to combine. As noted above, the only suggestion of motivation to combine asserted by the Examiner is “to allow a user to personalize the product”, thus merely citing an improved result based on hindsight analysis of Appellant’s system as claimed. Thus, for at least the reasons provided above, Appellant respectfully submits that Henson, Motomiya, and Risk, taken individually or in combination, fail to teach or suggest every element of Appellant’s claim 115.

Additionally, neither Henson, nor Barad, nor Risk provides a motivation to combine. The only suggestion of motivation to combine asserted by the Examiner is “to allow a user to personalize the product”, thus merely citing an improved result based on hindsight

analysis of Appellant's system as claimed. Thus, for at least the reasons provided above, Appellant respectfully submits that Henson, Barad, and Risk, taken individually or in combination, fail to teach or suggest every element of Appellant's claim 115.

Furthermore, the arguments presented above regarding claim 111 apply with equal force to claim 115. In light of all the arguments set forth above, the Examiner's rejection of claim 115 is erroneous.

**8. Claim Group 8: Claims 120, 122, and 127**

**A. Section 103(a) Rejection of Claims 120, 122, and 127 over Henson in view of Motomiya, and further in view of Risk**

Claims 120, 122, and 127 stand twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Motomiya et al. (U.S. Patent No. 6,083,267, henceforth Motomiya), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk).

**B. Section 103(a) Rejection of Claims 120, 122, and 127 over Henson in view of Barad, and further in view of Risk and IEEE Spectrum**

Claims 120, 122, and 127 stand twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Barad et al. (U.S. Patent No. 6,206,705 B1, henceforth Barad), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk) and IEEE Spectrum.

In addition to the limitations of independent claim 111, claim 120 includes the limitations: "wherein said providing the one or more customizable component options of the computer system includes providing an image of the computer system to the client system for display, wherein images of at least a subset of the one or more customizable components form at least a portion of the image of the computer system," and "wherein said receiving customizable component selections includes: receiving user input selecting an image of a first customizable component displayed in the image of the computer system, wherein said receiving user input selecting the image of the first

customizable component operates to select the first customizable component for configuration, and receiving user input selecting a first customizable component option for the first customizable component, wherein the user input selecting the first customizable component option comprises the customizable component selection for the first customizable component.”

Claim 122, dependent from claim 120, includes the further limitation, “wherein said receiving user input selecting the image of the first customizable component further includes: receiving user input indicating a position of a cursor of the client system overlaps the location of the image of the first customizable component displayed in the image of the computer system.”

Claim 127, dependent from claim 120 includes the further limitation, “wherein said receiving customizable component selections further includes: providing a sequence of images corresponding to the customizable component options of the first customizable component after said receiving user input selecting the image of the first customizable component.”

Appellant submits that neither Henson, Motomiya, nor Risk includes these limitations. For example, Henson provides no image of the configured system with customizable components at all, and Risk does not mention or even hint at e-commerce or presenting an image of the product to a user. Motomiya does disclose providing an image of configured jewelry, and even provides images of customizable components, however, in the system of Motomiya, the user selects customizable components by clicking on a category button, e.g., a “fasteners” button, “beads” button, or “equipment” button, which invokes a palette of component images from which the user then selects and configures, as illustrated in Figures 5A, 5B, and 6A, and described in column 4, line 28 through column 6, line 28. For example, when the user clicks on a fastener from the fastener palette, the selected fastener automatically replaces the previous fastener in the product image. While Motomiya does allow the user to click on the components included in the product image, this is only to rearrange or remove the components in or from the product image (see column 6, lines 7-9). The various component configuration options are displayed not on the product image, but rather in palettes or display areas

distinct from the product image, e.g., color's displayed around the beads button (Figures 5A, 5B, 6A, and 6B), fasteners displayed in a fasteners palette (Figure 5B), and so forth. Configuration of the components is effected by the user clicking on the desired component or component option displayed thusly. Thus, the user does not select the customizable component for configuration from the product image.

Similarly, while Barad does teach the display of the configured product in accordance with use-selected component configurations, Barad fails to teach selecting customizable components for configuration from the product image. Rather in Barad's system, options for component configuration are displayed separately from the configured product image, e.g., as groups or palettes of icons or images illustrating the component options. For example, as shown in Figure 7, various hairstyles, skin-tones, and eye colors are selectable from corresponding groups of icons or buttons, in response to which the product image is automatically updated to reflect the selected component options. As another example, Figure 17 illustrates display of various hair colors for the doll, again, displayed separate from the product image, from which the user may select to configure the doll's hair color. Thus, the user specifically does not select the customizable component for configuration from the product image itself.

Thus, both Motomiya and Barad fail to teach *receiving user input selecting an image of a first customizable component displayed in the image of the computer system, and receiving user input selecting a first customizable component option for the first customizable component*. More specifically, both Motomiya and Barad fail to teach *wherein the user input selecting the first customizable component option comprises the customizable component selection for the first customizable component*.

Neither does Motomiya or Barad teach or suggest *providing a sequence of images corresponding to the customizable component options of the first customizable component after said receiving user input selecting the image of the first customizable component* (which is included in the product image).

Thus neither Motomiya nor Barad teaches or suggests the limitations of claims 120, 122, or 127.

Moreover, as argued above, neither Henson, nor Motomiya, nor Risk provides a motivation to combine, nor does Henson, Barad, or Risk.

Furthermore, the arguments presented above regarding claim 111 apply with equal force to claims 120, 122, and 127. In light of all the arguments set forth above, the Examiner's rejection of claims 120, 122, and 127 is erroneous.

**9. Claim Group 9: Claims 126 and 130**

**A. Section 103(a) Rejection of Claims 126 and 130 over Henson in view of Motomiya, and further in view of Risk**

Claims 126 and 130 stand twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Motomiya et al. (U.S. Patent No. 6,083,267, henceforth Motomiya), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk).

**B. Section 103(a) Rejection of Claims 126 and 130 over Henson in view of Barad, and further in view of Risk and IEEE Spectrum**

Claims 126 and 130 stand twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Barad et al. (U.S. Patent No. 6,206,705 B1, henceforth Barad), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk) and IEEE Spectrum.

Claim 126 includes the limitation: "wherein the menu is operable to be displayed proximate to the location of the image of the first customizable component", where the menu comprises the customizable component options of the first customizable component.

Claim 130 includes the limitation: "the client system displaying the image of the configured computer system in response to said providing the one or more customizable component options of the customizable components to the client system, wherein images of at least a subset of the one or more customizable components are displayed in the image of the configured computer system, wherein, for each customizable component,

the one or more customizable component options are displayed proximate to the image of the customizable component”.

Claims 126 and 130 are separately patentable because the prior art does not suggest the limitations recited in these claims. As noted above, neither Henson nor Risk teaches display of a configured product at all, and so the below arguments are directed to Motomiya and Barad. For example, neither Motomiya nor Barad teaches displaying a menu proximate to the location of the image of the first customizable component, where the menu comprises the customizable component options of the first customizable component. Similarly, neither Motomiya nor Barad teaches displaying the image of the configured computer system where images of at least a subset of the customizable components are displayed in the image, and where, for each customizable component, the customizable component options are displayed proximate to the image of the customizable component. Rather, in both Motomiya and Barad, the customizable component options are displayed in respective areas or palettes separate and distinct from the configured product image, and are specifically *not* displayed proximate to the respective images of the customizable components.

Thus neither Motomiya nor Barad teaches or suggests the limitations of claims 126 or 130.

Moreover, as argued above, neither Henson, nor Motomiya, nor Risk provides a motivation to combine, nor does Henson, Barad, or Risk.

Furthermore, the arguments presented above regarding claim 111 apply with equal force to claims 126 and 130. In light of all the arguments set forth above, the Examiner’s rejection of claims 126 and 130 is erroneous.

#### **10. Claim Group 10: Claim 132**

##### **A. Section 103(a) Rejection of Claim 132 over Henson in view of Motomiya, and further in view of Risk**

Claim 132 stands twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Motomiya et al. (U.S. Patent No. 6,083,267, henceforth Motomiya), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk).

**B. Section 103(a) Rejection of Claim 132 over Henson in view of Barad, and further in view of Risk and IEEE Spectrum**

Claim 132 stands twice rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383, henceforth Henson) in view of Barad et al. (U.S. Patent No. 6,206,705 B1, henceforth Barad), and further in view of Risk (U.S. Patent No. 5,673,434, henceforth Risk) and IEEE Spectrum.

Appellant submits that claim 132 is separately patentable because the prior art does not suggest the limitations recited in this claim.

Claim 132 includes the limitation: “wherein the customizable component selections include one or more of: display, peripheral devices, storage devices, memory size, communication type, memory type.”

Claim 132 is separately patentable because the prior art does not suggest the limitations recited in this claim. As noted above, neither Henson nor Risk teaches display of a configured product at all, and so the below arguments are directed to Motomiya and Barad. For example, neither Motomiya nor Barad teaches or suggests a computer system, and specifically does not teach or suggest configurable system components that are computer devices, such as display, peripheral devices, storage devices, memory size, communication type, or memory type. Rather, Motomiya and Barad relate to jewelry and toys, respectively.

Thus neither Motomiya nor Barad teaches or suggests the limitations of claim 132.

Moreover, as argued above, neither Henson, nor Motomiya, nor Risk provides a motivation to combine, nor does Henson, Barad, or Risk.

Furthermore, the arguments presented above regarding claim 111 apply with equal force to claim 132. In light of all the arguments set forth above, the Examiner's rejection of claim 132 is erroneous.

## IX. CONCLUSION

For the foregoing reasons, it is submitted that the Examiner's rejection of claims 89-134 was erroneous, and reversal of his decision is respectfully requested.

If any fees are under or over paid, the Commissioner is authorized to charge or refund said fees to Meyertons Hood Kivlin Kowert & Goetzel, P.C. Deposit Account No. 50-1505/5150-40800/JCH.

This Appeal Brief is submitted in triplicate along with the following items:

- ☒ Return Receipt Postcard
- ☒ Deposit Account Fee Authorization form for the \$330.00 appeal brief fee.

Respectfully submitted,



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Date: June 10, 2004

## **X. APPENDIX**

The present claims on appeal are as follows:

89. A method for enabling a user to configure a measurement system in an e-commerce system, wherein the e-commerce system includes a client system coupled through a network to an electronic commerce server, the method comprising:

receiving a request from a user of the client system to configure the measurement system, wherein the measurement system includes one or more customizable components, wherein at least one of the customizable components is a measurement device;

providing customizable component options of the customizable components to the client system for display after receiving said request;

receiving customizable component selections for at least one of the one or more customizable components of the measurement system in response to user input, wherein the customizable component selections applied to the measurement system specify a configured measurement system; and

providing an image of the configured measurement system to the client system for display, wherein the image of the configured measurement system visually depicts the customizable component selections of the user.

90. The method of claim 89, wherein said providing the image of the configured measurement system includes providing customizable component selection images corresponding to the customizable component selections of the user.

91. The method of claim 90, wherein at least a subset of the customizable component selection images are visually depicted at their respective locations on the image of the configured measurement system.

92. The method of claim 91, wherein at least a subset of the customizable component selection images are displayed in the image of the configured measurement system.

115. The method of claim 89, wherein said providing the image of the configured measurement system includes providing text corresponding to the customizable component selections of the user;

wherein the text is visually depicted proximate to respective locations of the customizable components comprised in the image of the configured measurement system.

94. The method of claim 89, wherein the image of the configured measurement system appears substantially like the configured measurement system.

95. The method of claim 89, wherein the image of the configured measurement system is viewable by the user and used by the user to evaluate and confirm the customizable component selections.

96. The method of claim 95, further comprising:

receiving one or more new customizable component selections for at least one of the one or more customizable components of the configured measurement system after said providing the image of the configured measurement system to the client system, wherein the new customizable component selections applied to the configured measurement system specify a new configured measurement system;

providing an image of the new configured measurement system, wherein the image of the new configured measurement system visually depicts the new customizable component selections of the user.

97. The method of claim 89, wherein said receiving selections includes:

receiving user input selecting a first customizable component;

providing a menu of possible options for the first customizable component to the client system for display after the user input selecting the first customizable component;

receiving user input selecting one of the possible options for the first customizable component.

98. The method of claim 89, wherein said providing the one or more customizable component options of the measurement system includes providing an image of the measurement system to the client system for display, wherein images of at least a subset of the one or more customizable components form at least a portion of the image of the measurement system;

wherein said receiving customizable component selections includes:

receiving user input selecting an image of a first customizable component displayed in the image of the measurement system, wherein said receiving user input selecting the image of the first customizable component operates to select the first customizable component for configuration; and

receiving user input selecting a first customizable component option for the first customizable component, wherein the user input selecting the first customizable component option comprises the customizable component selection for the first customizable component.

99. The method of claim 98, wherein said receiving user input selecting the image of the first customizable component further includes:

receiving user input indicating a position of a cursor of the client system overlaps the location of the image of the first customizable component displayed in the image of the measurement system.

100. The method of claim 98, wherein said receiving customizable component selections further includes:

providing a menu comprising the customizable component options of the first customizable component for display on the client system after said receiving user input selecting the image of the first customizable component.

101. The method of claim 100, wherein the menu comprising the customizable component options includes text indicating the customizable component options.

102. The method of claim 100, wherein the menu comprising the customizable component options includes images indicating the customizable component options.

103. The method of claim 100, wherein the menu is operable to be displayed proximate to the location of the image of the first customizable component

104. The method of claim 98, wherein said receiving customizable component selections further includes:

providing a sequence of images corresponding to the customizable component options of the first customizable component after said receiving user input selecting the image of the first customizable component.

105. The method of claim 98, wherein said receiving user input selecting the first customizable component option includes:

providing customizable component option images corresponding to the customizable component options of the first customizable component;

receiving user input selecting a first customizable component option image corresponding to the first customizable component option.

106. The method of claim 89, wherein said providing customizable component options of the customizable components to the client system includes providing images of the customizable component options to the client system.

107. The method of claim 98, further comprising:

providing an image of the first customizable component option for display on the client system in response to said receiving user input selecting the first customizable component option for the first customizable component.

108. The method of claim 98, further comprising:

the client system displaying the image of the configured measurement system in response to said providing the one or more customizable component options of the customizable components to the client system, wherein images of at least a subset of the one or more customizable components are displayed in the image of the configured measurement system;

wherein, for each customizable component, the one or more customizable component options are displayed proximate to the image of the customizable component.

109. The method of claim 89, further comprising:

the client system displaying one or more customizable component options of the customizable components in response to said providing the one or more customizable component options of the customizable components to the client system; and

the client system displaying the image of the configured measurement system in response to said providing the image of the configured measurement system to the client system for display, wherein the displayed image of the configured measurement system visually depicts the customizable component selections of the user.

110. The method of claim 109, wherein the customizable component selections include one or more of: measurement card; cable, signal conditioning modules and transducer.

111. A method for enabling a user to configure a computer system in an e-commerce system, wherein the e-commerce system includes a client system coupled through a network to an electronic commerce server, the method comprising:

receiving a request from a user of the client system to purchase the computer system, wherein the computer system includes one or more customizable components;

providing customizable component options of the customizable components to the client system for display after receiving said request;

receiving customizable component selections for at least one of the one or more customizable components of the computer system in response to user input, wherein the

customizable component selections applied to the computer system specify a configured computer system; and

providing an image of the configured computer system to the client system for display, wherein the image of the configured computer system visually depicts the customizable component selections of the user.

112. The method of claim 111, wherein said providing the image of the configured computer system includes providing customizable component selection images corresponding to the customizable component selections of the user.

113. The method of claim 112, wherein at least a subset of the customizable component selection images form at least a portion of the image of the configured computer system.

114. The method of claim 112, wherein at least a subset of the customizable component selection images are displayed in the image of the configured computer system.

115. The method of claim 111, wherein said providing the image of the configured computer system includes providing text corresponding to the customizable component selections of the user;

wherein the text is visually depicted proximate to respective locations of the customizable components comprised in the image of the configured computer system.

116. The method of claim 111, wherein the image of the configured computer system appears substantially like the configured measurement system.

117. The method of claim 111, wherein the image of the configured computer system is viewable by the user and used by the user to evaluate and confirm the customizable component selections.

118. The method of claim 117, further comprising:

receiving one or more new customizable component selections for at least one of the one or more customizable components of the configured computer system after said providing the image of the configured computer system to the client system, wherein the new customizable component selections applied to the configured computer system specify a new configured computer system;

providing an image of the new configured computer system, wherein the image of the new configured computer system visually depicts the new customizable component selections of the user.

119. The method of claim 111, wherein said receiving selections includes:

receiving user input selecting a first customizable component;

providing a menu of possible options for the first customizable component to the client system for display after the user input selecting the first customizable component;

receiving user input selecting one of the possible options for the first customizable component.

120. The method of claim 111, wherein said providing the one or more customizable component options of the computer system includes providing an image of the computer system to the client system for display, wherein images of at least a subset of the one or more customizable components form at least a portion of the image of the computer system;

wherein said receiving customizable component selections includes:

receiving user input selecting an image of a first customizable component which is displayed in the image of the computer system, wherein said receiving user input selecting the image of the first customizable component operates to select the first customizable component for configuration; and

receiving user input selecting a first customizable component option for the first customizable component, wherein the user input selecting the first customizable component option comprises the customizable component selection for the first customizable component.

121. The method of claim 111, wherein said providing customizable component options of the customizable components to the client system includes providing images of the customizable component options to the client system.

122. The method of claim 120, wherein said receiving user input selecting the image of the first customizable component further includes:

receiving user input indicating a position of a cursor of the client system overlaps the location of the image of the first customizable component displayed in the image of the computer system.

123. The method of claim 120, wherein said receiving customizable component selections further includes:

providing a menu comprising the customizable component options of the first customizable component for display on the client system after said receiving user input selecting the image of the first customizable component.

124. The method of claim 122, wherein the menu comprising the customizable component options includes text indicating the customizable component options.

125. The method of claim 122, wherein the menu comprising the customizable component options includes images indicating the customizable component options.

126. The method of claim 122, wherein the menu is operable to be displayed proximate to the location of the image of the first customizable component

127. The method of claim 120, wherein said receiving customizable component selections further includes:

providing a sequence of images corresponding to the customizable component options of the first customizable component after said receiving user input selecting the image of the first customizable component.

128. The method of claim 120, wherein said receiving user input selecting the first customizable component option includes:

providing customizable component option images corresponding to the customizable component options of the first customizable component;

receiving user input selecting a first customizable component option image corresponding to the first customizable component option.

129. The method of claim 120, further comprising:

providing an image of the first customizable component option for display on the client system in response to said receiving user input selecting the first customizable component option for the first customizable component.

130. The method of claim 120, further comprising:

the client system displaying the image of the configured computer system in response to said providing the one or more customizable component options of the customizable components to the client system, wherein images of at least a subset of the one or more customizable components are displayed in the image of the configured computer system;

wherein, for each customizable component, the one or more customizable component options are displayed proximate to the image of the customizable component.

131. The method of claim 111, further comprising:

the client system displaying one or more customizable component options of the customizable components in response to said providing the one or more customizable component options of the customizable components to the client system; and

the client system displaying the image of the configured computer system in response to said providing the image of the configured computer system to the client system for display, wherein the displayed image of the configured computer system visually depicts the customizable component selections of the user.

132. The method of claim 131, wherein the customizable component selections include one or more of: display, peripheral devices, storage devices, memory size, communication type, memory type.

133. A memory medium comprising program instructions for enabling a user to configure a measurement system in an e-commerce system, wherein the e-commerce system includes a client system coupled through a network to an electronic commerce server, wherein the program instructions are executable to implement:

receiving a request from a user of the client system to configure the measurement system, wherein the measurement system includes one or more customizable components, wherein at least one of the customizable components is a measurement device;

providing customizable component options of the customizable components to the client system for display after receiving said request;

receiving customizable component selections for at least one of the one or more customizable components of the measurement system in response to user input, wherein the customizable component selections applied to the measurement system specify a configured measurement system; and

providing an image of the configured measurement system to the client system for display, wherein the image of the configured measurement system visually depicts the customizable component selections of the user.

134. A memory medium comprising program instructions for enabling a user to configure a computer system in an e-commerce system, wherein the e-commerce system includes a client system coupled through a network to an electronic commerce server, wherein the program instructions are executable to implement:

receiving a request from a user of the client system to purchase the computer system, wherein the computer system includes one or more customizable components;

providing customizable component options of the customizable components to the client system for display after receiving said request;

receiving customizable component selections for at least one of the one or more customizable components of the computer system in response to user input, wherein the customizable component selections applied to the computer system specify a configured computer system; and

providing an image of the configured computer system to the client system for display, wherein the image of the configured computer system visually depicts the customizable component selections of the user.